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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,325	12/10/2001	Bryan C. Dunkeld	KOP 2001-1	4756
23694 7590 12/07/2007 J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704			EXAMINER AUGUSTIN, EVENS J	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 12/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/016,325

Applicant(s)

DUNKELD ET AL.

Examiner

Evens Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/03/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-37 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This is in response to an amendment filed on August 3rd, 2007. Claims 59-80 have been added. Claims 22-37, 55 and 59-80 are pending. Claims 1-23 and 31-35 have been examined.

Response to Arguments

Applicant's arguments with respect to claims 22-37, 55 and 59-80 have been considered but are moot in view of the new ground(s) of rejection, necessitated by applicant's amendment.

Claim Interpretation

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
3. It should also be noted that, in the office action that:
 - A. Items in the rejection that are in quotation marks are claimed language/limitations
 - B. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
 - C. Functional recitation(s) using the word "for" or other functional terms (*e.g.* "for monitoring operation of a self service terminal application exceeded by a self service terminal coupled to the computer" as recited in claim 8) have been considered but

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given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- D. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations.
- E. Word(s) that are separated by “/” are being examined as being synonymous
- F. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Cir. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

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- G. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- H. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 22, 24, 25, 27, 35, and 37, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 22-37 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Kane et al. (U.S. 20030097299).

As per claims 22-37 and 55, O’Kane et al. discloses an invention that relates to the art of transferring data files between users and, more specifically, to the use of peer to peer processing for this purpose. The invention comprises of the following:

- A P2P network with a plurality of clients (first, second or third) connected to it (par. 56)–
Claims 22, 23
- The client computers include software module that is operable (or executable) to enable these machines to access the network and be capable of consuming system resources provided by other systems connected to the network (aka managing the transfer/download of content) (par. 58) – *Claim 22*
- The aspect of content instantiation is being interpreted by the PTO as being content transfer or download. Accordingly, each time the content is downloaded (first, second or third time), the downloaded content has unique tag (par. 62) – *Claims 22, 24*
- Paragraph 16 of the prior art teaches that users in the art can use cellular phone, Personal Digital Assistant etc, as client devices – *Claim 25*
- Audio files such as MP3 format (par. 96)-*Claim 26*
- The **unique tag** is based on the IP address of the originated and computer and file name to be downloaded (par. 62) – *Claims 27, 55*
- The basics of P2P operation are a user requests a file(s) to be downloaded and the other user or server makes available the file(s) to be downloaded (par. 10-13) – *Claim 28*
- Computer program executable to complete an authorization procedure (par. 90).
authorization procedures also enable the digital information to be distributed for a limited number of uses/users, thus enabling per-use fees to be charged for the digital information

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(par. 50). Implicitly, a transaction account has to set up in order to charge users for content. Additionally, the language in claim 30 does not require steps of “setting up account” to be performed – *Claims 29-30*

- A system that manages that upload and download of files through the P2P network (par. 64) – *Claims 31-32*
- The current invention will allow a person to send a file once and see it **hosted** by dozens or even thousands of potential consumers on a network (par. 39, 52, 56, 57)–*Claim 33*
- Provides payments to the parties involved for performing the hosting function (par. 52, 69) – *Claim 33*
- Requesting or polling for files (par. 64) –*Claim 34*
- Prior art teaches the aspect of digital content which includes among other things, text, graphical images, sound files, and the like (par. 6, 96-101). Books and magazines would fall under the category of text or graphical images – *Claim 35*
- Transfers and downloads must oblige to United States copyright laws such as the Digital Millennium Act of 1998 (par. 31) – *Claim 36*
- The client device can be an MP3 or video player (par. 112), and it is well established in the art that MP3 player can be part of personal entertainment system –*Claim 37*
- Client computers having memory (par. 56-58) – *Claim 55*

Conclusion


8. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant’s amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/
Evens J. Augustin
October 15, 2007
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